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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,123	01/29/2004	William A. Margiloff	E03.002/U	4363
28062	7590	08/18/2006	EXAMINER	
BUCKLEY, MASCHOFF, TALWALKAR LLC			AIRAPETIAN, MILA	
5 ELM STREET			ART UNIT	
NEW CANAAN, CT 06840			PAPER NUMBER	
			3625	

DATE MAILED: 08/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/767,123	Applicant(s) MARGILOFF ET AL.	
	Examiner Mila Airapetian	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/29/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/15/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful, concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”:

(a) “Useful” – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the

claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible" – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" – Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

The claims, as currently recited, appear to be directed to nothing more than a series of steps including *determining* and *arranging* information, such as advertising information, without any tangible result and are, therefore, deemed to be non-statutory.

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While this information may be concrete and/or useful, there does not appear to be any tangible result.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the following limitation "*wherein the advertising is provided to the user device via a communication network and is provided to the user ...*" which is confusing. The step of "*providing*" is not positively claimed. Therefore, it is not clear should the recited limitation be given patentable weight.

Claim 4 recites the following limitation "*wherein said arranging comprises displaying a graphical advertisement to the user*" which is confusing. The step of "*displaying*" is not positively claimed. Therefore, it is not clear should the recited limitation be given patentable weight.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-7, 10-12 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Skillen et al. (US 6,098,065).

Claim 1. Skillen et al. (Skillen) teaches a computer-implemented method for providing advertisements to the users, comprising:

locally determining at a user device advertising information based on (i) contextual information associated with remote information being accessed by a user (col. 1, lines 39-49; col. 2, lines 35-39), and (ii) supplemental information associated with the user col. 3; lines 13-19); and arranging for the advertising information to be provided to the user (col. 1, lines 39-49).

Claim 2. Skillen teaches said method wherein the supplemental information is associated with at least one of: (i) geographic information, (ii) user device information, and (iii) other advertising information that has been provided to the user (col. 3, lines 13-19).

Claim 5. Skillen teaches said method wherein the contextual information comprises a key word (col. 4, lines 12-13).

System claims 6, 7 and 10 repeat the subject matter of method claims 1, 2 and 5 respectively, as a set of apparatus elements rather than a series of steps. As the underlying processes of claims 1, 2 and 5 have been shown to be fully disclosed by the

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teachings of Skillne in the above rejections of claims 1, 2 and 5, it is readily apparent that the system disclosed by Skillen includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1, 2 and 5, and incorporated herein.

Claims 11, 12 and 15 are rejected on the same rationale as set forth above in Claims 1, 2 and 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 8, 9, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh et al. (US 6,876,974).

Claim 3. Skillen teaches all the limitations of claim 3 including that the advertising information is provided to the user device via a communication network (col. 3, lines 52-55). However, Skillen does not teach that said advertising information is provided to the user when the user device is not communicating via the communication network.

Marsh et al. (Marsh) teaches a computer-implemented method for providing advertisements to the users wherein advertisements are presented to users during periods of off-line activity (col. 7, lines 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Skillen to include that advertising information is provided to the user when the user device is not communicating via the communication network, as disclosed in Marsh, because it would advantageously allow to avoid the downloaded during the on-line access advertisements become “stale”, thereby avoiding the risk of users being numbed or otherwise negatively affected by their advertising as a result of overexposure, as specifically taught by Marsh (col. 2, lines 52-60).

Claim 4. Skillen teaches all the limitations of claim 4 except that said arranging comprises displaying a graphical advertisement to the user.

Marsh teaches said method wherein graphical advertisements are displayed to the user (col. 6, line 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Skillen to include that said advertisements include graphical advertisements, as disclosed in Marsh, because it would advantageously allow to recognize said advertisements instantaneously, thereby increasing efficiency of advertising.

System claims 8 and 9 repeat the subject matter of method claims 3 and 4 respectively, as a set of apparatus elements rather than a series of steps. As the

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underlying processes of claims 3 and 4 have been shown to be fully disclosed by the teachings of Skillne and Marsh in the above rejections of claims 3 and 4 it is readily apparent that the system disclosed by Skillen and Marsh includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 3 and 4 and incorporated herein.

Claims 13 and 14 are rejected on the same rationale as set forth above in Claims 3 and 4.

Conclusion

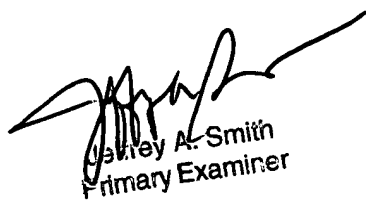
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ma



Jeffrey A. Smith
Primary Examiner